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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/698,651 | 10/30/2003 | Bennett Johnston | JOHN-101/USA/P | 3757 |
| 7590 | 03/09/2006 | | EXAMINER | |
| Thomas W. Cook Thomas Cook Intellectual Property Attorneys 3030 Bridgeway, Suite 425-430 P.O. Box 1989 Sausalito, CA 94965 | | | PIERCE, WILLIAM M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3711 | |
| | | | DATE MAILED: 03/09/2006 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | |
|------------------------|---------------------|
| Application No. | Applicant(s) |
| 10/698,651 | JOHNSTON, BENNETT |
| Examiner | Art Unit |
| William M. Pierce | 3711 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 December 2005.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 20-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 20-43 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34-39 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as set forth in the previous office action;

Another of the subject matters courts have found to be outside the four statutory categories of invention is abstract ideas. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939).

In the instant case, the key is that there exists no "concrete or tangible result. In order for an "abstract idea" to be statutory subject matter analogous to a method of doing business it must produce a useful, concrete and tangible result. The examiner does not dispute the usefulness requirement. Games cannot be disputed for their usefulness in entertainment. However, the result must also be "concrete" and "tangible". By definition something which is concrete is "having a material, perceptible existence; of, belonging to, or characterized by things or events that can be perceived by the senses; real; actual and something which is tangible is "that can be touched...having actual form and substance". In the instant invention the results are intangible. The episodic memory and the semantic memory systems are different and used differently from person to person. While applicant's specification points to results of "playfulness", these results are considered subjective and not concrete and tangible as required. In addition there exists no evidence of record that supports any concrete and tangible results. As such, absent of any evidence of any "tangible results", the claims would remain rejected under 101.

In another perspective, the claims are drawn to a mere arrangement of printed matter in the form or "instructions". Though seemingly a "manufacture," such is not within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

Moreover, "memory" in the broadest sense is a scientific principle that exists in nature. Such things occurring in nature, which is substantially unaltered, is not a "manufacture". *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941). And a scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854). Broadly here the instant claims can be viewed as an attempt to gain the rights to exclude based on the use of memory in a question and answer game. Such human memory exists in nature and under scientific principle and is considered non-statutory subject matter.

Further the disclosed invention is inoperative and therefore lacks utility. The episodic memory and the semantic memory systems are different and used differently from person to person. Persons do not have control over which systems of memory they resort to when facing a question or a problem. It is usually a combination memory systems in varying degrees depending upon the person. See the reference to Human Memory attached to this office action. For example, the question may be to list as many "rivers" as possible (from applicant's fig. 2). A player may answer from episodic memory based a rafting trip or his semantic memory based on his geography course. With regard to question and answer games in general, a player inherently uses all combinations of memory systems stimulated to a varying and unique degree that are necessary for them to use to formulate the best possible answer to the question or task before them. Another example would be from applicant's fig. 3, "the best vistas" could come from pictures in a history book or a past vacation depending upon the person and their state of mind when face with the question. To say that a particular question will only stimulate one, two, three or a combination of memory systems is not operative since such is dependent upon the person and their memory functions and not on the question.

Art Unit: 3711

Claims 20-33 and 40-42 are considered apparatus claims as set forth in the grounds for rejection below.

With respect to the above claims, in para. 3 of his remarks, applicant states that his method “produce tangible results (the responses)”. First, it is the Office position that a “response is not tangible”. In the claims the response is the “retrieval of information from the memory of the game players”. Clearly according to the claimed method the “response” is intangible in that it only occurs in the minds of the players and one cannot touch, see, feel or observe the results. To be statutory, a process must result in a physical transformation for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan. In the claimed process there exists no physical transformation in that the cards and the players exist in the same state after practicing the claimed method as they did before. No tangible results are achieved by practicing the claimed invention. All “responses” only exist in the minds of the players and have no real world application. After performing the claimed process, nothing new exists so there is no transformation that is required of a process to be statutory. Nor are the players improved in any measurable way (i.e. smarter). Hence there is no practical application within the technological arts as required by a process that is statutory. See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) (“A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.”). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring). Second, the response is not “concrete”, particularly when the results are not assured nor can be reproducible. In presenting a direction to a player, there is no way to determine which facet of his memory a player will use to respond to that direction.

Claims 20-43 are rejected under 35 U.S.C. 101 because the claimed invention is inoperative for the reasons set forth in the previous office action. Specifically using claims 20 and 34 to illustrate the examiner’s position with respect to this grounds for rejection. Claim 20 recites “the performance of each unique task predictably requires retrieval of information from primarily one of a plurality of human memory systems and claim 34 recites how “direction calls for retrieval of information from memory using primarily a single first human memory system...second human memory system”. Such recitations are inoperative since a person uses all facets of his memory in order to respond to a direction as they would deem to be appropriate. For example, whether a person uses information based upon a personal experience or based upon a fact memorized at school when reacting to a direction, is subjective. A direction

Art Unit: 3711

is incapable of "calling" from a specific human memory system. Ultimately it is dependent upon the player's individuality which determines which part of his memory will be used. As such these claims are considered inoperative. Applicant's remarks in para. 6 and in the inventors memorandum have been considered but are deemed not persuasive. More specifically to the inventors memorandum he discusses the semantic memory system as one that "contains conceptual and factual knowledge" and the episodic memory as that "must be recollected in the context of a particular time and place with reference to oneself as a participant in the episode". As set forth above, this is memory of a personal experience. To illustrate the examiner position that a direction cannot determine from which part of the human memory that a player will use, it is asked to consider the direction in the form of the question, "what color is the sky?" From elementary school science class one remembers that the sky is blue. So that would be the response. However, the same player or even another player from his episodic memory may remember camping one evening where the sky was pink. Depending upon the frame of mind of the player, the facet of his memory that is used is subjective and cannot be directed with any amount of predictability. As such the claimed invention is considered inoperative and remains rejected.

At the bottom of para. 6, applicant states that the control over which system of memory a player resorts to "is supplied by the structure of the game". However, this structure is NOT set forth in the claims. Nor are examples of this structure that is recited in the claims specifically pointed out. As such it cannot be relied on to distinguish over the applied art.

Claim Rejections - 35 USC § 112

Claim 23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 23 and 27, the meets and bounds of "information game players have no reason to remember the next day" is unclear in that it is subjective with no definite way to determine what a player will or will not remember the next day. As such there is no definite way to determine what type of information the claim is reciting.

Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose moving the marker of another player when it occupies an intersection.

Art Unit: 3711

Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 21 recites process steps that fail to further limit the structure of the previously claimed apparatus. "The performance of each unique task..." does not limit the structure of the game kit as required of a dependant claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry 4,714,255 in view of Alexander 6,279,909 as set forth in the previous office action;

As to claims, Henry shows a game board of intersecting first and second paths in combination with a plurality of collections of instructions in fig. 4 that stimulate the human memory. Inherently the player uses all of his memory systems, short-term, semantic and episodic memory systems, available to him based upon his individual ability in order to answer the question. Alternatively, while Henry factual trivia question, Alexander teaches that a mix of tasks, questions and actions can be in a trivia type game. To have added tasks such as that taught by Alexander would have been obvious in order to make the game more interesting to the players by offering a more variety of questions. With respect the applicant's use of the term "instructions" per se, broadly it has been held that the addition of instructions for how to use a device cannot impart patentability. See *In re Ngai* (5/13/04)(*Michel, Garjarsa, Linn*)(per curiam).

Further while Henry and Alexander fail to discuss the science behind the memory skills use in the answering of the game tasks, it has been clearly held that a property or a scientific explanation of the prior art's functioning does not negate the fact that the prior art inherently possessed the claimed element. "Insufficient prior understanding of inherent properties of a known composition does not defeat a finding of anticipation" *Atlas Powder Co. v. Ireco Inc.*, 19 F.3d 1342, 51 USPQ 2d 1943 (Fed. Cir. 1999).

With respect to paragraphs 4 and 5 of applicant's argument, they do not discuss limitations that are present in the above claims and are considered moot.

As to claims 20, 28, 32 and 40, such are considered apparatus claims. Alexander teaches a plurality of sets of cards 24, each of which bears a unique direction such as a question or a task to perform. The remaining limitations recited in the new apparatus claims of "the cards may be drawn..." and "the performance of each unique task..." fail to further limit the claimed invention by distinguishing over the applied art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32

Art Unit: 3711

(Fed. Cir. 1997). As to claims 22, 29, 33 and 42, shown by Henry is a playing surface 1 marked with a plurality of indicia with a first path 2 and a second path 4 and markers in fig. 2. As to claim 23, 30 and 41, taught is a third set of cards in Alexander's 24. As to claims 24 and 31, Henry shows a plurality of intersections 20 on the playing surface that the players "may occupy". With respect to claim 25, no "means for" are recited and such is not interpreted as invoking 35 USC 112, sixth paragraph limitation requirements into this claim. As such the functional limitations as to what how the structure is to be used in playing the game to "require responses associated primarily with a single second human memory system" and "call for a second type of response" relates only to the printed matter and fails to distinguish over the applied art. More specifically to claim 25, the first and second "collection" is considered shown in the cards of Alexander in the cards as discussed above with respect to claim 20. What the "first directions call for" and how they "may be presented to game players" relates only to the intended method of use or play that fails to further distinguish this apparatus from the applied art. As to claim 26, the recited "game display" is considered to be the board 1 as set forth in claim 20 above with its first and second paths 2 and 4 respectively. Claim 27 is shown in the third cards as set forth above with respect to claim 23. In claims 34 and 43, Alexander teaches using different types of cards 24a with different types of directions that calls for a player to retrieve information from memory using the first human memory system. Further shown is a second direction 24b that allows a person to answer using a second human memory system. As to claim 35 and 36, fairly taught is first and second paths as set forth above with respect to claim 22. In Henry, the marker is moved along a path after responding to a question as called for in claims 37 and 38. As to claim 39, it is known to game to remove another marker of a player when it occupies the same space.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3711

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

A handwritten signature in black ink, appearing to be a stylized 'W' or a similar character, is positioned here.